Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ALEX S. TOBACK

Appeal No. 2004-0083
Application No. 09/639,599

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Alex S. Toback appeals from the final rejection (Paper No. 5, mailed December 4, 2002) of claims 1 to 24, all of the claims pending in the application. Before considering the appeal on its merits, we find it necessary to remand the application to the examiner under the authority of 37 CFR § 1.196(a).

In the final rejection, the examiner rejected the claims as follows:

1. Claims 1 to 24 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art[1] in view of Orowan[2].

2. Claims 4 to 7 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan as applied to claim 1 above, and further in view of Good et al.[3] (Good).

3. Claims 8 to 15 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan and Good.

4. Claims 18, 21 and 24 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan as applied to claims 16, 19 and 22 above, and further in view of Good.

In the brief (Paper No. 9, filed June 2, 2003), the appellant set forth his arguments as to why the rejections set forth in the final rejection were in error.

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[1] The appellant admitted in the application (specification, page 1; Figures 1(a), 2 and 9) that it was known in the art to use numerous fasteners to connect a steel stiffening strap to a gusset plate (Admitted Prior Art).

[2] U.S. Patent No. 3,655,424 issued April 11, 1972.

[3] U.S. Patent No. 4,426,425 issued January 17, 1984.

In the answer (Paper No. 10, mailed July 2, 2003), the examiner rejected the claims as in the final rejection and added a further rejection (pp. 4-5) of claims 1 to 3, 16, 17, 19, 22 and 23 under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Orowan.[4]

In the rejections before us in this appeal, the examiner (1) ascertained that the Admitted Prior Art does not disclose applying an adhesive curable at room temperature to at least the panel or the support structure and placing them against each other; and (2) concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an adhesive material in the connection of the Admitted Prior Art in light of the teachings of Orowan that it is known to use an adhesive material between plates of a lap joint used in a connection with rivets or other fasteners.[5]

All the claims under appeal recite that the adhesive is curable at room temperature. However, in the rejections before us in this appeal the examiner has not either (1) determined that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the Admitted Prior Art by using an

[4] The appellant did not file a reply brief.

[5] Good teaches a two-part epoxy adhesive that is curable but does not teach that the two-part epoxy adhesive is curable at room temperature. Good teaches that the two-part epoxy adhesive is heated at 100° C for twenty minutes and then allowed to cool.

adhesive curable at room temperature[6] to supplement the fasteners in connecting the steel stiffening strap to the gusset plate; or (2) set forth a rationale supporting a conclusion that the product-by-process limitation that the adhesive is curable at room temperature does not affect the product itself (i.e., the claimed connection system or assembly) and therefore does not impart patentability to the product. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.). See also Atlantic Thermoplastics Co. v. Faytex Corp., 970 F.2d 834, 8443-47, 23 USPQ2d 1481, 1488-91 (Fed. Cir. 1992). Once the appellant has been provided with a rationale supporting a conclusion that the claimed product appears to be the same or similar to that suggested by the prior art, although produced by a different process, the burden shifts to the appellant to come forward with evidence establishing an unobvious difference between the claimed product and the product suggested by the prior art. See In re Marosi, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983).

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[6] The appellant admits (specification, p. 3) that an adhesive curable at room temperature is known. However, the examiner has not applied this known curable adhesive in the rejections under appeal.

Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

We remand this application to the examiner to supply a supplemental answer which sets forth a rationale as to why the applied prior art would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the Admitted Prior Art by using an adhesive curable at room temperature to supplement the fasteners in connecting the steel stiffening strap to the gusset plate; and/or sets forth a rationale as to why the product-by-process limitation that the adhesive is curable at room temperature does not affect the product itself. Pursuant to 37 CFR § 1.193(b)(1), the appellant may file a reply brief to the supplemental answer within two months from its date of mailing. If upon reconsideration of the rejections the examiner determines that the appealed rejections should be withdrawn, the requirement for a supplemental answer would, of course, become null and void.

CONCLUSION

To summarize, the application has been remanded to the examiner for further action.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge)
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